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| 10/574,847 | 04/06/2006 | Masaki Tsujimoto | 062289 | 5518 |
| 38834 7590 06/14/2011 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036 | | | | |
| EXAMINER | | | | |
| MCCLELLAND, KIMBERLY KEIL | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentmail@whda.com

Office Action Summary

Application No.

10/574,847

Applicant(s)

TSUJIMOTO ET AL.

Examiner

KIMBERLY K. MCCLELLAND

Art Unit

1745

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 4 and 8-14 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 8-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 April 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 07/16/10, 07/27/10
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant is reminded they need to explicitly point out where support for all the newly claimed features comes from as required by MPEP 714.02 and 2163.06. See 37 CFR 1.111.

Claim Objections

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 14 and 15 have been renumbered 13 and 14.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the closed loop cut on the film having a width less than a width of said film must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1 and 8-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly added limitation in independent claim 1 of a "closed loop cut on the film having a width less than a width of said film"

appears to be new matter. Applicant has not indicated where support for the newly added claim language may be found. The drawings do not illustrate this feature. The specification does not disclose this feature. Clarification is required. Dependent claims 8-15 are rejected due to dependency on independent claim 1.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent NO. 6,634,401 to Kuhn et al. in view of U.S. Patent Application Publication No. 2004/0009650 to Jeong et al.

8. With respect to claim 1, Kuhn et al. discloses a tape applicator, including a table with an adherend (2); a support device (102) capable of supporting a strip material including a film stuck on a surface of a base sheet; pre-cutting device (122) having a first member (122) located on a film side of the strip material and a second member (130) located on a base sheet side of the strip material, thereby forming a pre-cut portion of said; a peeling device (154) for peeling the pre-cut portion of said film from said base sheet, said peeling device being located downstream of said pre-cutting device in the sheet feeding direction; and a press roller (152) positioned at a downstream end of said peeling device, in the sheet feeding direction for pressing the

pre-cut portion so as to stick said pre-cut portion to the adherend, wherein said pre-cutting device is configured such that the cut is made from a face of said film opposite the face of said film which is to be peeled from the base sheet by said peeling device, and wherein said press roller is configured to press the pre-cut portion of said film on the face of said film opposite the face of said film peeled from the base sheet by said peeling device (See Figure 3). Kuhn does not specifically disclose a ring shaped first adherend and a plate shaped second adherend are disposed, the second adherend being disposed inside of the first adherend or a pre-cutting device having a first member located on a film side of the strip material and a second member located on a base sheet side of the strip material, the first member having a blade which forms a closed loop cut on the film, said closed loop having a width less than a width of said film

9. Jeong discloses an attaching unit, including a ring shaped first adherend (152) and a plate shaped second adherend (150) are disposed on a table, the second adherend being disposed inside of the first adherend and a pre-cutting device having a first member (136) located on a film side of the strip material and a second member (128) located on a base sheet side of the strip material, the first member having a blade which forms a closed loop cut on the film, said closed loop having a width less than a width of said film (Figures 7-9). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the adherends and closed loop cutting device taught by Jeong with the applicator of Kuhn. The motivation would have been to use blades to provide for a variety of shapes in the removable tape portions (column 11, lines 10-15).

10. The examiner would like to note that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997); “[A]pparatus claims cover what a device is, not what a device does.” Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). See MPEP § 2114.
11. As to claim 13, Kuhn does not specifically disclose the first member includes a rotation member capable of rotating about an axis parallel to the surface of the film and the second member is a receiving plate, and wherein said blade which forms said closed loop is held by the free end side of the rotation member.
12. Jeong discloses an attaching unit, including a rotation member capable of rotating about an axis parallel to the surface of the film and the second member is a receiving plate, and wherein said blade which forms said closed loop is held by the free end side of the rotation member (Figure 9). It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the cutting means taught by Yamamoto for the precutting means of Kuhn et al. Simple substitution

of one known cutting device for another would produce the predictable result of effectively cutting tape from a web.

13. Claims 8 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent NO. 6,634,401 to Kuhn et al. in view of U.S. Patent Application Publication No. 2004/0009650 to Jeong et al. as applied to claims 1 and 14 above, and further in view of U.S. Patent No. 5,730,816 to Murphy.

14. With respect to claim 2, Kuhn et al. does not specifically disclose the tension control means comprises a dancer roller, which is movable vertically so as to allow the strip material to be fed out toward said press roller while giving tension due to its own weight to said strip material or first and second sensors for detecting a raised position and a lowered position of the dancer roller respectively.

15. Murphy discloses a label stripping apparatus, including a dancer roller (103), which is movable vertically so as to allow the strip material to be fed out toward said press roller while giving tension due to its own weight to said strip material and first and second sensors for detecting a raised position and a lowered position of the dancer roller respectively (column 4, lines 5-8). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the first and second sensors taught by Murphy with the tension means of Kuhn et al. The motivation would have been to provide more responsive control of the feeding and tension of the tape web.

16. Examiner would like to note that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In *re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997); "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). See MPEP § 2114.

17. As to claim 14, Kuhn does not specifically disclose the first member includes a rotation member capable of rotating about an axis parallel to the surface of the film and the second member is a receiving plate, and wherein said blade which forms said closed loop is held by the free end side of the rotation member.

18. Jeong discloses an attaching unit, including a rotation member capable of rotating about an axis parallel to the surface of the film and the second member is a receiving plate, and wherein said blade which forms said closed loop is held by the free end side of the rotation member (Figure 9). It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the cutting means taught by Yamamoto for the precutting means of Kuhn et al. Simple substitution of one known cutting device for another would produce the predictable result of effectively cutting tape from a web.

19. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent NO. 6,634,401 to Kuhn et al. in view of U.S. Patent Application Publication No. 2004/0009650 to Jeong et al. as applied to claims 1 and 13 above, and further in view of U.S. Patent No. 3,860,473 to Wesen.

20. With respect to claim 9, Kuhn et al. does not specifically disclose said pre-cutting means includes a die receiving plate and a die roller having a cutter blade formed on a roller.

21. Wesen discloses an apparatus for making labels, including said pre-cutting means includes a die receiving plate (205) and a die roller (201) having a cutter blade (200) formed on a roller (see Figure 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the cutting means taught by Wesen for the precutting means of Kuhn et al. Simple substitution of one known cutting device for another would produce the predictable result of effectively cutting labels from a web.

22. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent NO. 6,634,401 to Kuhn et al. in view of U.S. Patent Application Publication No. 2004/0009650 to Jeong et al. and U.S. Patent No. 5,730,816 to Murphy as applied to claims 2 and 14 above, and further in view of U.S. Patent No. 3,860,473 to Wesen.

23. With respect to claim 10, Kuhn et al. does not specifically disclose said pre-cutting means includes a die receiving plate and a die roller having a cutter blade formed on a roller.

24. Wesen discloses an apparatus for making labels, including said pre-cutting means includes a die receiving plate (205) and a die roller (201) having a cutter blade (200) formed on a roller (see Figure 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the cutting means taught by Wesen for the precutting means of Kuhn et al. Simple substitution of one known cutting device for another would produce the predictable result of effectively cutting labels from a web.

25. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent NO. 6,634,401 to Kuhn et al. in view of U.S. Patent Application Publication No. 2004/0009650 to Jeong et al. as applied to claims 1 and 13 above, and further in view of U.S. Patent Application Publication No. 2003/0044481 to Beaudry.

26. With respect to claim 11, Kuhn et al. does not specifically disclose said pre-cutting means includes a movable roller and a die plate having a circular blade formed thereon.

27. Beaudry discloses a cutting device for use with labels (see paragraph 0002), including said pre-cutting means includes a movable roller (26) and a die plate (see paragraph 0063) having a circular blade formed thereon (32; see Figure 13). It would have been obvious to one of ordinary skill in the art at the time the invention was made

to substitute the cutting means taught by Beaudry for the precutting means of Kuhn et al. Simple substitution of one known cutting device for another would produce the predictable result of effectively cutting labels from a web.

28. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent NO. 6,634,401 to Kuhn et al. in view of U.S. Patent Application Publication No. 2004/0009650 to Jeong et al. and U.S. Patent No. 5,730,816 to Murphy as applied to claims 2 and 13 above, and further in view of U.S. Patent Application Publication No. 2003/0044481 to Beaudry.

29. With respect to claim 12, Kuhn et al. does not specifically disclose said pre-cutting means includes a movable roller and a die plate having a circular blade formed thereon.

30. Beaudry discloses a cutting device for use with labels (see paragraph 0002), including said pre-cutting means includes a movable roller (26) and a die plate (see paragraph 0063) having a circular blade formed thereon (32; see Figure 13). It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the cutting means taught by Beaudry for the precutting means of Kuhn et al. Simple substitution of one known cutting device for another would produce the predictable result of effectively cutting labels from a web.

Response to Arguments

31. Applicant is reminded they need to explicitly point out where support for all the newly claimed features comes from as required by MPEP 714.02 and 2163.06. See 37 CFR 1.111.

32. Applicant's arguments with respect to claims 1 and 8-15 have been considered but are moot in view of the new ground(s) of rejection. Applicant's amendment necessitated the new grounds of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KIMBERLY K. MCCLELLAND whose telephone number is (571)272-2372. The examiner can normally be reached on 8:00 a.m.-5 p.m. Mon-Thr.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip C. Tucker can be reached on (571)272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kimberly K McClelland/
Examiner, Art Unit 1791

KKM